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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,987	09/05/2000	Aiden Flanagan	S63.2-8765	7494

490 7590 03/25/2002

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

YAO, SAM CHAUN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 03/25/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-V

Office Action Summary	Application No.		Applicant(s)	
	09/654,987		FLANAGAN, AIDEN	
	Examiner		Art Unit	
	Sam Chuan C. Yao		1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, 24-25 & 27-30, drawn to a process of sealing at least one polymeric material to a polymeric catheter tube. Claim 24 of this group requires simultaneous bonding of at least two polymeric materials to a catheter tube by "simultaneously generating a first annular beam ... and a second annular beam ..." (emphasis added); but does not require "forming a fluid tight seal ... positioning a polymeric dilation member along and in surrounding relation to a polymeric body ... generating an annular beam of substantially monochromatic electromagnetic energy" required in claim 17; **or** "simultaneously welding the proximal and distal ends of a balloon made of polymeric material to a catheter tube by simultaneously controllably directing the first and second annular beam toward the end portions of the balloon as required in claim 26.
- II. Claims 17-23, drawn to forming a fluid tight seal between a polymeric body and a polymeric dilatation member. Claim 17 of this group requires "positioning a polymeric dilation member along and in surrounding relation to a polymeric body ... generating an annular beam of substantially monochromatic electromagnetic energy"; but does not recite simultaneous bonding of at least two polymeric materials to a catheter tube by "simultaneously generating a first annular beam ... and a second annular beam ..." (emphasis added) as recited in claim 24; **or** "simultaneously

welding the proximal and distal ends of a balloon made of polymeric material to a catheter tube" (emphasis added) by simultaneously controllably directing the first and second annular beam toward the end portions of the balloon as required in claim 26.

- III. Claims 1-16 & 26-30, drawn to a process for simultaneously welding the proximal and distal ends of polymeric balloon to a catheter tube. Claim 26 of this group requires simultaneously controllably directing the first and second annular beam toward the end portions of the balloon, but does not require "simultaneously generating a first annular beam ... and a second annular beam ..." as recited in claim 24; or "forming a fluid tight seal ... positioning a polymeric dilation member along and in surrounding relation to a polymeric body ... generating an annular beam of substantially monochromatic electromagnetic energy" required in claim 17.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I-III are directed to distinct methods, where patentability in the independent claims of each group is based on divergent combination of method steps as noted above. The differences between these groups are critical and significant to the extent that the inventions constitute prima facie patentably distinct combinations, absent evidence to the contrary. This can readily and clearly be demonstrated by a side-by-side comparison of the independent claims. Similarities of the independent claims are merely superficial, since certain significant limitations in one of the groups find no counterpart in the other group(s) and vice versa.

Presently, **claims 1-16 and 27-30 are taken to be linking claims to groups I and III. Rejoinder** of these groups will be considered, upon indication of allowable subject matter, depending on the basis thereof.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-III; and vice versa, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: the energy is substantially monochromatic;

Species B: the energy is NOT substantially monochromatic.

Species M: the polymeric material is a retention sleeve;

Species N: the polymeric material is a sheath or catheter tube.

Species S: the annular beam is substantially circular;

Species T: the annular beam is NOT substantially circular.

Species X: the entire annular beam is directed onto the polymeric material

Species Y: a portion of the annular beam is blocked.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 or 17 or 27 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Because of the complexity of the restriction/election requirement, no attempt was made for Applicant to make an oral election over the phone to the above restriction requirement.


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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

scy
March 19, 2002